



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

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Washington, D.C. 20231APPLICATION NUMBER _____ FILING DATE _____ FIRST NAMED APPLICANT _____ ATTORNEY DOCKET NO. VB

EXAMINER _____

ART UNIT _____

PAPER NUMBER 5

DATE MAILED: _____

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on February 22, 1999 and 4/1/99, 9/20/99, 11/08/99
(requests for corrected filing receipts)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~The claim is~~ The claim is ~~_____~~ pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ ~~The claim is~~ The claim is ~~_____~~ rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17 2(a)).

*Certified copies not received _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/255107

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of application for patent in the United States

The claim **remains** rejected under 35 U.S.C. 102(b) as being anticipated by **NZ. PBR ROS 511** (application and denomination published on January 14, 1995); or resulting **Grant/Reg. Number 1131** (published on October 14, 1996); or **GB Grant/Reg. Number 5467** (published on December 30, 1995) taken in view of the admission that "***the rose variety of the subject application was placed on public sale in the United Kingdom in November, 1992***" (emphasis added), as set forth at page 2 of applicant's October 01, 2001 response.

This rejection was previously set forth and discussed in paragraph 1 of paper number 12 (mailed December 27, 2001). Applicant's arguments have been considered but are not found persuasive.

It remains the Office's position that each of the published foreign documents set forth above constitutes a printed publication under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Weyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). The plant breeder's right grants are entered in the Register of Plant Novelties, and a notice is published when a variety is entered in the Register. In the European Community, every two months the Community Plant Variety Office published an Official Gazette containing all the information appearing in its Registers. Other information the CPVO feels important to the public may also be published in the Gazette.

Thus, information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art more than one year prior to the date of filing in the United States. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publications standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied upon to show that the primary reference has an enabling disclosure (*In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985)). See also MPEP Section 2131.01. When the claim is drawn to a plant, the reference, combined with the knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant (*In re LeGrice*, 201 F.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure (*Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Board of Patent Appeals and Interferences, 1992)). The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications. (See also MPEP section 2121.03

Applicant has admitted at page 2 of the October 1, 2001 response that plants of the Haryup variety were made available to the public outside of the United States more than one year prior to the filing date of the instant application, specifically in November, 1992. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application's U.S. filing date.

The above referenced foreign publications are thus enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson, supra*. See also Cooper, *Biotechnology and the Law*, Section 8.05 (1998 Clark, Boardman Callaghan). In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice* 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992).

Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publication standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. That plants of the instant cultivar were admittedly made available more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson*.

supra. See also Cooper, Biotechnology and the Law, section 8.05 (1998 Clark Boardman Callaghan). In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.

The contention that foreign commercial or public use is not a bar to patentability under 35 U.S.C. 102(b) is again noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country more than one year prior to the date of the application for patent in the United States." There is no restriction of the bar under 35 U.S.C. 102(b) to printed publications in this country. That is, the statute explicitly extends the scope of the bar from printed publications to this or a foreign country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because a rejection under 35 U.S.C. 102(b) over the foreign published documents, as enabled by the admitted availability of the plants outside the U.S. more than one year prior to the date of domestic filing, is not over public use or sale, but on a printed publication.

The argument that the claimed plant was not available in the United States more than one year prior to domestic filing is not persuasive, as applicant is attempting to create a geographic component of enablement, which does not exist in statute or in case law. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* (10 USPQ2d 1710), where a specification was found to be enabling even though the required biological material was only available in the ocean off the coast of Central and South America. Even if there were a requirement that the plant be available in the United States,

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applicant has not explained why the skilled rose grower could not have purchased the claimed plant and arranged for its importation into the United States through the usual channels (customs and USDA quarantine).

Arguments relative to the foreign documents becoming available only at the time of publication of the grant thereof are erroneous. Each of these documents was available to the interested public at the time that the application was published.

Arguments that any information contained in the foreign publications would not enable a person skilled in the art to reproduce and thereby be in possession of the claimed plant with just a written description are not persuasive, because a more detailed description of the claimed cultivar would not confer novelty. See MPEP 2112.

The continuing argument that the plant in *In re LeGrice* was available only in a foreign country and that the fact situation there is the same as in the instant application is not persuasive because in *LeGrice* applicant never admitted that the rose cultivar was on sale anywhere. Instead applicant stated, "Prior public use or sale are the avenues by which a plant enters the public domain" (*LeGrice* page 372). The court then added "section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter" (page 372).

The contention that the Court knew that the claimed plant had been on sale and found that fact irrelevant is contrary to the written opinion cited above. The *LeGrice* decision repeatedly returns to the question of whether the invention was "in the possession of the public". Clearly, if an invention is on sale to the public, then the public must have possession of it. As stated by the Board of Appeals and Interferences in *Ex Parte Thomson*, "the court's holding was based on the specific printed publications before it, and no indication was given that the prior catalogue publication before it evidenced commercial availability in a readily enabling form" (p. 1622).

That the examiner should not rely upon *Ex Parte Thomson* because that case involved an application for a utility patent is not persuasive because the question in *Thomson* as in *LeGrice* was what is required to enable a printed publication describing a plant? Except for the type of patent sought, the instant application presents the same fact pattern as in the *Thomson* case. Moreover, applicant has misconstrued the *Thomson* decision. The printed publications cited in *Thomson* were not enabled by applicant's deposit of seeds but by the commercial availability of the seeds outside the U.S. As stated in *Thomson*, "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercially available Siokora seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokora plants, seeds and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokora seeds readily available on the open market."

Applicant argues that the published information relative to the cultivar Haryup could not have enabled one skilled in the art to reproduce the plant. This argument is not persuasive because no amount of description would be an enabling disclosure. Public notice of a Plant Breeder's Right application informs the public of the existence of the plant. Sale or other public use of said plant then puts it in the public's possession. If a plant is in the public's possession, then a printed publication can be a statutory bar. The following is a passage from *LeGrice*, page 379:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

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The sale or use of the plant in the public domain and the knowledge in a printed application would enable a person skilled in the art to reproduce the plant, thus the publication is a statutory bar under 35 U.S.C. 102(b).

Arguments raised relative to the propriety of use of a combination of references in an effort to anticipate an invention under 35 U.S.C. 102(b) have been addressed in the above rejection, which sets forth the rationale.

Arguments brought forth relative to substantive departure from prior practice within the art and unfairness to applicant have been considered but are not persuasive. The only change in policy is in the use of rule 1.105, which was published in the Federal Register in the PBG advance notice, notice of proposed rulemaking and final rule. While applicant has referred to the 102(b) rejection as the policy change, the substantive policy is the implementation of the existing 35 U.S.C. 102(b) to a given factual pattern, hardly a substantive policy change. The factual pattern is analogous to the opinion in *Ex Parte Thomson*, which demonstrates the strength of 35 U.S.C. 102(b) under such circumstances. The USPTO cannot ignore 35 U.S.C. 102(b) just because of the recognition of a recurring factual pattern that runs counter to that paragraph where it may not have been recognized before.

The balance of applicant's arguments have been carefully considered, but have not been found persuasive, and warrant no further comment at this time.

2 THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event that a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campbell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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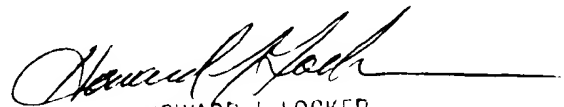
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TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

June 26, 2002



HOWARD J. LOCKER
EXAMINER

GROUP ART UNIT *1661*